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27 October 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re The Danielson Company, Inc.

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Serial No. 76406586

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Stephen M. Evans of Graybeal Jackson Haley LLP for The  
Danielson Company, Inc.

Gwen Stokols, Trademark Examining Attorney, Law Office 102  
(Thomas Shaw, Managing Attorney).

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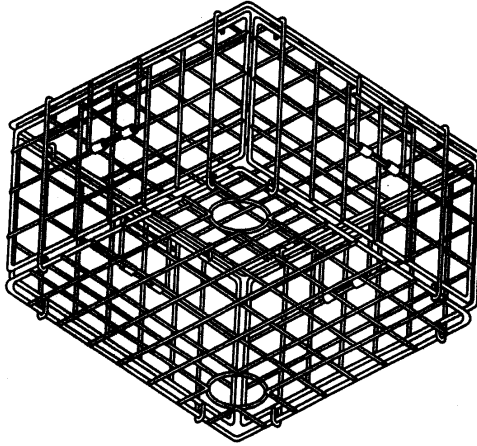
Before Hohein, Walters and Drost, Administrative Trademark  
Judges.

Opinion by Drost, Administrative Trademark Judge:

The Danielson Company, Inc. (applicant) has applied to  
register the mark shown below on the Principal Register  
under the provision of Section 2(f) of the Trademark Act  
for "crab traps" in International Class 28.<sup>1</sup>

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<sup>1</sup> Serial No. 76406586 filed May 9, 2002, and alleging a date of  
first use and first use in commerce of 1976.



The application describes the mark as "a three dimensional product design configuration of a crab trap having a generally square foot print and a height generally between 40% to 60% of its length or width." Applicant, with respect to its mark, also asserts as follows (Response dated May 5, 2003 at 2):

Applicant states for the record that it is not claiming distinctiveness (lack of functionality) with respect to the existence of unidirectional swing gates or escape rings. These elements of the product design configuration are functional. Also functional is an enclosure sufficiently resistant to unintentional animal escape. Nor is applicant claiming distinctiveness with respect to the use of panel grids constructed of vinyl coated welded wire. These elements of applicant's trap (as opposed to the other elements of applicant's trap that are claimed as part of its product design configuration for which registration is sought) are essential to the use or purpose of the product: an escape resistant enclosure having one or more entrance locations, means for preventing unintentional escape and regulation compliance escape rings. Beyond these functional requirements, it is applicant's contention that the remaining aspects of its product design configuration are non-functional and therefore appropriate subject

matter for registration: a three dimensional product design configuration of a crab trap having a generally square foot print and a height generally between 40% to 60% of its length or width.<sup>2</sup>

The examining attorney has refused registration on the grounds that the design is functional under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), and, that, if the mark is not functional, "the mark is a non-distinctive product configuration within the meaning of Trademark Act Sections 1, 2 and 45, 15 U.S.C. Sections 1051, 1052, and 1127, which has failed to acquire distinctiveness under Trademark Act Section 2(f)." Examining Attorney's Brief at 1.<sup>3</sup> The examining attorney argues that "the configuration

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<sup>2</sup> Applicant's brief (p. 3, n.4) contains the following statement: "While the Examining Attorney correctly indicated that the drawing does not comport with this inherent exclusion, applicant offers to amend the drawing to comport with the claim should the more fundamental questions regarding registrability be resolved in applicant's favor." The examining attorney responds (Brief at 3 n.2) by noting that the "applicant's drawing does not feature broken lines to depict the portion of the mark that is claimed; however, the Office has determined that the applicant's description of what it does and does not claim is sufficiently clear. In the event that the TTAB finds that the mark is registrable, the description of what is and is not claimed as part of the mark will appear on the certificate of registration." However, without a drawing utilizing broken lines or an amended description of the mark, it is not clear how this description will appear on the registration certificate. Therefore, we will consider the design in the drawing of record. Inasmuch as applicant has explained that much of the drawing is clearly functional, if applicant's mark is not functional, it will be because of the features applicant and the examining attorney discuss in their briefs.

<sup>3</sup> "In the first and final office actions, the examining attorney, referring to Trademark Act Sections 1, 2 and 45, also refused registration because the mark would not otherwise be perceived as a source identifier. This refusal is actually subsumed within

that the Board must consider is simply a cube cut approximately in half, horizontally." Examining Attorney's Brief at 3. The examining attorney refers to applicant's design as a "half-cube." The examining attorney held that the design was functional because a "trap that is square on all sides is more likely to tip over and roll; a rectangular trap with a bottom featuring a larger surface area is less likely to tip." Examining Attorney's Brief at 4. In addition, the examining attorney found that applicant's design was easier to manufacture. Finally, the examining attorney was not persuaded, in that alternative, that applicant's evidence of sales of less than 27,000 traps in a recent year, advertising, and settlement agreements, demonstrated that applicant's design had acquired distinctiveness.

On the other hand, applicant argues that its claimed design serves no utilitarian purpose "[n]or does the claimed shape and proportions of the product provide identifiable utilitarian advantages to the user; the vast diversity of alternative designs ... clearly support applicant's contentions that its product design

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the stated refusal that the mark is a configuration that has not acquired distinctiveness. Accordingly, this brief will address only the two refusals stated above (functional and non-distinctive configuration)." Examining Attorney's Brief at 2 n.1.

configuration geometry does not have a particular shape because it works better in that shape." Applicant's Brief at 5.

### Functionality

The Trademark Act has been amended expressly to provide that an application may be refused registration if it "comprises any matter that, as a whole, is functional." 15 U.S.C. § 1052(2)(5). The Supreme Court has addressed the issue of functionality in several cases both before and after this statutory change.

Discussing trademarks, we have said "[i]n general terms, a product feature is functional,' and cannot serve as a trademark, 'if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.'" Qualitex Co. v. Jacobson Products Co., 514 U.S. 159, 165 (1995) (quoting Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 850, n. 10 (1982)). Expanding upon the meaning of this phrase, we have observed that a functional feature is one the "exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage." 514 U.S., at 165.

TraFFix Devices Inc. v. Marketing Displays Inc., 523 U.S. 23, 58 USPQ2d 1001, 1006 (2001).

The Federal Circuit looks at four factors when it considers the issue of functionality:

- (1) the existence of a utility patent disclosing the utilitarian advantages of the design;
- (2) advertising materials in which the originator of the design touts the design's utilitarian advantages;

- (3) the availability to competitors of functionally equivalent designs; and
- (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product.

Valu Engineering Inc. v. Rexnord Corp., 278 F.3d 1268, 61 USPQ2d 1422, 1426 (Fed. Cir. 2002), citing In re Morton-Norwich Products, Inc., 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982).

We will analyze the issue of functionality using the four factors set out in Valu Engineering.

(1) Existence of a Utility Patent

We first look at the question of whether there is a prior utility patent that is relevant to the question of whether applicant's design is functional. The Supreme Court has indicated that a utility patent can be a critical factor in a functionality determination.

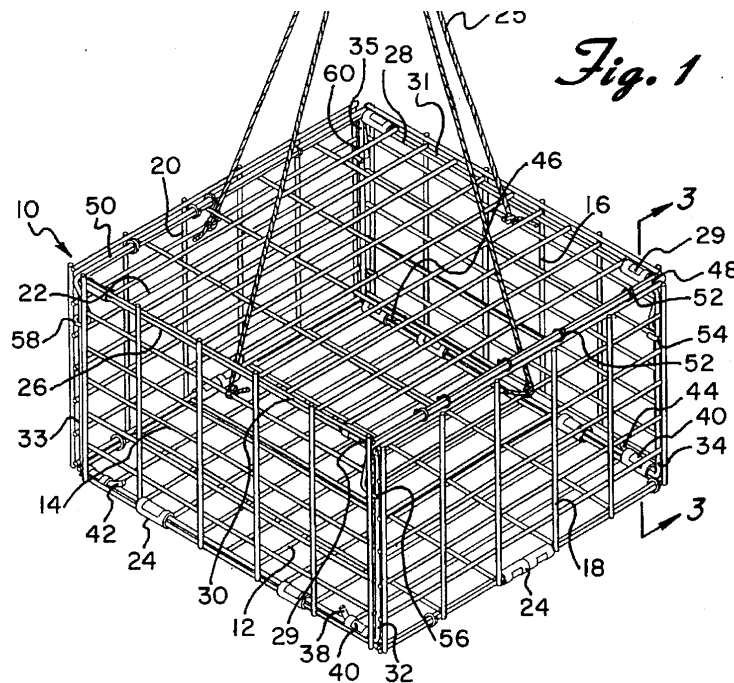
A prior patent, we conclude, has vital significance in resolving the trade dress claim. A utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features, the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection.

TrafFix, 58 USPQ2d at 1005. "Moreover, it is not only the specific claims made in the patent which are relevant; statements made in a patent application and in the course

of procuring a patent also may demonstrate the functionality of the design." M-5 Steel Mfg. Co. v. O'Hagin's Inc., 61 USPQ2d 1086, 1096 (TTAB 2001).<sup>4</sup>

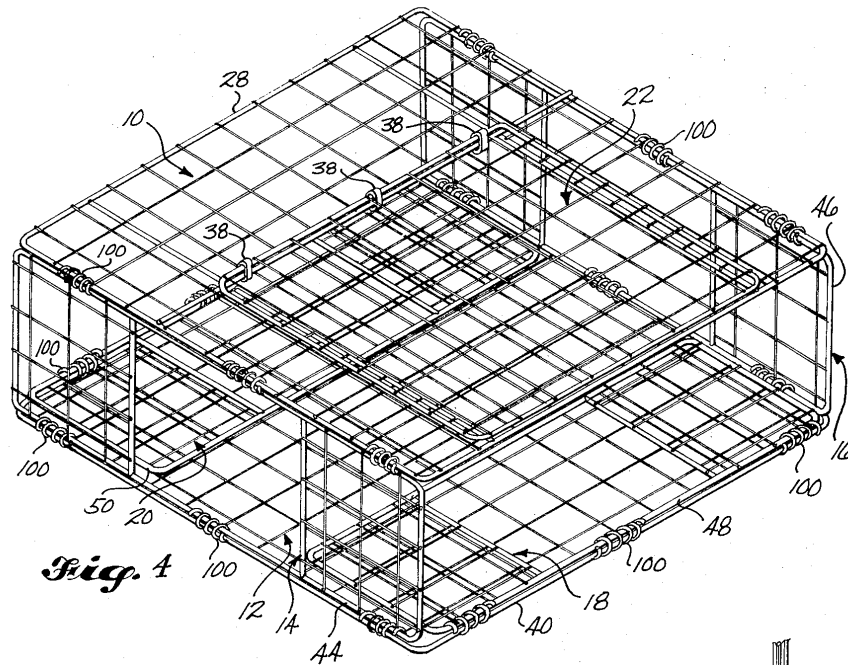
The examining attorney and applicant have placed several patents in the record. The first relevant patent is No. 5,625,978, issued May 6, 1997, for a "collapsible crab trap." The drawing is remarkably similar to applicant's design.

Patent No. 5,625,978:



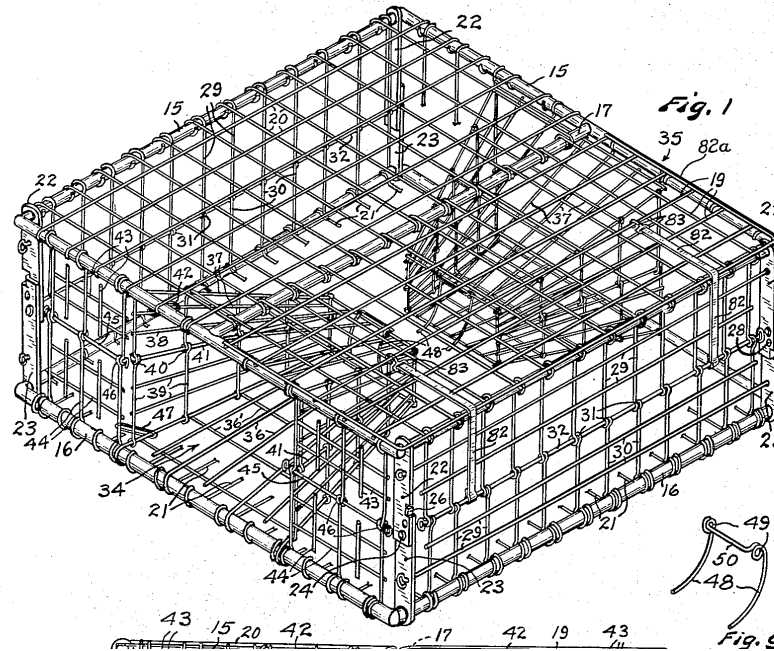
<sup>4</sup> Even an "abandoned patent application should be considered under the first Morton-Norwich factor, because an applied-for utility patent that never issued has evidentiary significance for the statements and claims made in the patent application concerning the utilitarian advantages, just as an issued patent has evidentiary significance." Valu Engineering, 61 USPQ2d at 1429.

There are other patents that show a basic design that is similar to applicant's design. See, e.g., Patent Nos. 2,760,297 and 3,795,073.



Patent No. 3,795,073.





Patent No. 2,760,297.

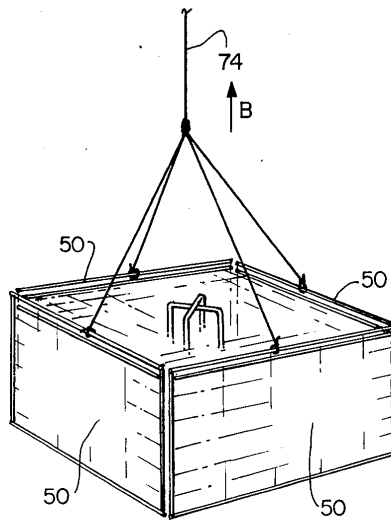
These patents demonstrate that the "half-cube" design is considered a common design for crab trap patents.<sup>5</sup>

Another patent describes the prior art as follows:

"Conventional prior art crab traps of the collapsible type comprise a square base member having square sides pivotally connected thereto." Patent No. 4,044,493, col. 1, lines

<sup>5</sup> Applicant cannot distinguish drawings in the patents on the ground that they might not be exactly within applicant's specified dimensions because "it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue." Hockerson-Halberstadt, Inc. v. Avia Group International, Inc., 222 F.2d 951, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000). In addition, applicant refers to its design having a "generally" square footprint and its height being "generally" between 40% to 60% of its length or width. The patent drawings show designs having a "generally" square footprint and "generally" within the specified dimensions.

10-14. The patent goes on to summarize that the object of the invention is to "provide a crab trap in which the side profile is a rectangle" and the side members have a rectangular shape in which the ratio of width to length is about 3:5. This provides a profile which appears to entice crabs to enter the trap." '493 patent, col. 1, lines 41-42 and col. 2, lines 3-5. Figure 5 from the '493 patent, which is described as "a crab trap of the present invention in the closed state" (col. 2, lines 23-24), is set out below.



**FIG. 5**

A square base member with rectangular sides produces a design that is similar to applicant's "half-cube" design.<sup>6</sup>

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<sup>6</sup> Patent No. 2,769,274; col. 1, lines 58-64 contains a description of "a practical size" for a rectangular, box-like crab trap. "[I]t would be about forty inches long, thirty inches wide, and eighteen inches high. It is to be understood, however, that these dimensions are not critical and the trap might be

The Supreme Court has explained that:

Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.

TraFFix, 58 USPQ2d at 1005.

Here, there is no indication that the square base with rectangular sides of applicant's dimensions is an ornamental, incidental, or arbitrary aspect of the crab traps.<sup>7</sup> Indeed, applicant's design appears to be a common element in numerous crab trap designs for which the USPTO has issued utility patents. Thus, these patents are strong evidence that applicant's design is functional.

(2) Advertising Materials Disclosing Utilitarian Advantages

The literature of record makes it clear that there are utilitarian advantages to have a base that is shorter than the sides such as applicant's "half-cube" design. For example, the E-Z Catch® 2 Door Intermediate is described as

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larger or smaller according to desires or requirements, without departing from the invention." While not a square, this patent does disclose a crab trap whose height is approximately 40% to 60% of its length and width.

<sup>7</sup> "In a case where a manufacturer seeks to protect arbitrary, incidental, or ornamental aspects of features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs, a different result might obtain. There the manufacturer could perhaps prove that those aspects do not serve a purpose within the terms of the utility patent." TraFFix, 58 USPQ2d at 1007.

having "[w]eighted doors and a larger footprint to assure a proper set." The E-Z Catch® Half-Trap: Low Profile advertisement contains the following statement: "Two or Four funnel, wide footprint trap that sets well for day or overnight." This literature discloses a utilitarian advantage to a crab trap of applicant's design. This advantage, as the examining attorney argues (Brief at 5), is that "applicant's trap has the broader footprint necessary for stability." Therefore, the advertising literature provides some evidence of the functionality of applicant's design.

(3) Alternative Designs

Applicant argues that examining attorney's exhibits illustrate "the incredible diversity of designs utilized in the crab trap market... Given this diversity, it cannot be reasonably maintained that applicant's claimed proportional relationship between length, width and height in a rectilinear trap is necessarily superior to other trap shapes and sizes." Applicant's Brief at 3. The Federal Circuit has noted that the fact that other designs are available does not mean that applicant's design is not functional:

We did not in the past under the third factor require that the opposing party establish that there was a "competitive necessity" for the product feature.

Nothing in TrafFix suggests that consideration of alternative designs is not properly part of the overall mix, and we do not read the Court's observations in TrafFix as rendering the availability of alternative designs irrelevant. Rather, we conclude that the Court merely noted that once a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available. But that does not mean that the availability of alternative designs cannot be a legitimate source of evidence to determine whether a feature is functional in the first place.

Valu Engineering, 61 USPQ2d at 1427 (footnote omitted).

The fact that there are alternative designs is hardly surprising, or in and of itself, legally sufficient. Obviously, crab traps, like the road sign in TrafFix, have existed prior to the design at issue in this case. The evidence of record clearly demonstrates that crab traps have been around for many years. The question is not whether there are alternative designs that perform the same basic function but whether these designs work "equally well." Valu Engineering, 61 USPQ2d at 1427, quoting, 1 McCarthy on Trademarks and Unfair Competition, §7:75, 7-180-1 (4<sup>th</sup> ed. 2001). The Supreme Court found that it was improper to engage in "speculation about other design possibilities, such as using three or four springs which might serve the same purpose ... [or] to explore designs to hide the springs." TrafFix, 58 USPQ2d at 1007. While

these alternative designs presumably catch crabs, the evidence does not support a conclusion that they perform equally as well as applicant's design. Therefore, the presence of other designs does not indicate that applicant's design is not de jure functional.

- (4) Facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product

The examining attorney (Brief at 5) has noted that a:

[F]unctional feature of the configuration is its ease of manufacture. The trap has six sides. The top and bottom pieces are square-shaped and the same size. The four side pieces are rectangular and are the same size. Thus, the applicant (or other licensed manufacturer) need manufacture only two different shapes in order to produce its crab trap. Ease of manufacture will help the applicant keep down the costs of the crab traps.

Obviously, a crab trap where all the sides are identical and the top and bottom feature match would make it easier to manufacture. There would be no need to store the sides separately and the replacement of a damaged side piece is a simple matter of finding another side piece. If competitors wanted to have the utilitarian advantages of the broader footprint of applicant's design, the half-cube design would be a fairly simple design to use. Thus, this factor also favors the examining attorney's position that applicant's design is de jure functional.

Functionality Analysis

When we consider the evidence of record, we must determine whether applicant's design as a whole is functional. 15 U.S.C. § 1052(2)(5) ("No trademark ... shall be refused registration on account of its nature unless it ... (5) comprises any matter that, as a whole, is functional"). A feature is "functional when it is essential to the use or purpose of the device or when it affects the cost or quality of the device." TrafFix, 58 USPQ2d at 1006 (internal quotation marks omitted). In this case, applicant's "half-cube" design would, as a whole, be functional. Applicant's design is commonly found in crab trap patents issued by the U.S. Patent and Trademark Office. The literature indicates that crab traps with a similar design set more easily and, as the examining attorney indicates, this design is less likely to tip over. To require competitors to design around applicant's basic half-cube crab trap would impact the cost or quality of the device. For example, if competitors attempted to practice the invention as depicted in many of the referenced U.S. patents, they would risk running afoul of applicant's trademark claims unless they modified the basic design in the patents. Applicant's design appears to be the best combination of a simple manufacturing process with the

utilitarian advantages of setting properly and stability. Therefore, we find that the examining attorney has met her burden of establishing a prima facie case of de jure functionality and applicant has not rebutted this prima facie case.

#### Acquired Distinctiveness

While we have affirmed the functionality refusal, applicant has sought registration on the basis that its design has acquired distinctiveness. "Because applicant's designs are functional, any evidence of distinctiveness is of no avail to applicant in support of registration."

O'Hagin's, 61 USPQ2d at 1097. See also TrafFix, 58 USPQ2d at 1007 ("Functionality having been established, whether MDI's dual-spring design has acquired secondary meaning need not be considered"). Therefore, even if there were evidence sufficient to demonstrate acquired distinctiveness, it would not permit the registration of a functional design. However, for the sake of completeness, should applicant ultimately prevail on the issue of functionality, we will discuss applicant's contention that its design has acquired secondary meaning.

We note that a product design, "like color, is not inherently distinctive." Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000).



Inasmuch as applicant does not maintain that its mark is inherently distinctive, the only issue is whether the design has acquired distinctiveness.

It is applicant's burden to prove acquired distinctiveness. Yamaha International Corporation v. Hoshino Gakki Co., Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988); In re Hollywood Brands, Inc., 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954)("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant"). "[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." Yamaha, 6 USPQ2d at 1008.

However, the statute is silent as to the weight of evidence required for a showing under Section 2(f) except for the suggestion that substantially exclusive use for a period of five years immediately preceding filing of an application may be considered prima facie evidence.

As observed by our predecessor court, the exact kind and amount of evidence necessarily depends on the circumstances of the particular case, and Congress has chosen to leave the exact degree of proof necessary to qualify a mark for registration to the judgment of the Patent Office and the courts. In general, the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.

Id. (quotation marks, brackets, and citations omitted).

In support of its argument that the mark has acquired distinctiveness, applicant argues (Brief at 6) that it:

a) established that the product comprising the mark had been in substantially continuous and exclusive use since at least 1975; b) provided sales figures for the then most current year for such data (over 26,000 such traps sold during the 2001-2002 season); c) represented that the product was both advertised and sold without marketing collateral, i.e., it is sold in a clear poly bag for easy consumer inspection and identification without the use of a conventional word trademark; and d) provided evidence of several settlement agreements wherein selected competitors of applicant were informed of their infringement of applicant's rights and ceased infringing conduct.

The claim that applicant has been using a design for a long period of substantial and exclusive use does not demonstrate that the mark has acquired distinctiveness.

See In re Gibson Guitar Corp., 61 USPQ2d 1948, 1952 (TTAB 2001) (66 years of use). In addition, the mere fact that applicant has sold over 26,000 traps in a recent year is not in and of itself persuasive since we have no evidence of the percentage of the market this number of traps would constitute. Id. ("As for the sales of 10,000 in a two-year period, again there is no evidence to show whether this is a large number of sales of guitars vis-à-vis the sales of other companies"). We also point out that applicant's deluxe folding crab trap is advertised as selling for \$16.99 with coupon and \$18.59. Thus, another question left unanswered by applicant is whether approximately \$500,000

in crab trap sales is significant. Even if these sales figures were significant, it would not establish that the applicant's design was the basis for the success. O'Hagin, 61 USPQ2d at 1098 ("[W]hile applicant's sales may demonstrate popularity or commercial success for its roof vents, such evidence alone does not demonstrate that the vents' designs which applicant seeks to register have become distinctive of its goods and thus function as source indicators").

Indeed, when we view applicant's advertising set out below, it is not clear if prospective purchasers would even recognize applicant's design as a trademark.

Danielson  
Danco, FTC  
Folding Crab Trap  
A favorite for sport and recreational crabbers. Vinyl coated steel wire. Folds flat for storage and easy transportation.

Danielson 24'' Deluxe Crab Trap is a favorite of sport and commercial crab fisherman. Built to last with vinyl coated steel wire construction. Features entrance doors, two escape holes and a fold-open, snap-lock upper latch. Folds flat for moving and storage.

We note that despite applicant's claim that its traps are marketed in clear plastic bags, the advertising associated with the traps does contain word trademarks or trade names. In addition, these ads do not contain any indication "that [applicant] has promoted the asserted product designs as

trademarks, and we have no evidence that consumers have come to recognize applicant's designs as indications of origin." O'Hagin, 61 USPQ2d at 1098.<sup>8</sup> Indeed, most of the ads do not even contain the dimensions of the crab trap. Even when the dimensions appear, they appear to be informational like the dimensions for other products on the page. For example, the MAGIC page advertises the following products with dimensions:

- (1) Deluxe Crab Trap - "24''L x 24''W x 13''H, Folds Flat, Meets Current Biodegradable
- (2) APEX Crab Trap - 14'' x 14'' - 9 3/8'' High
- (3) Worm Farm - 8 5/8 x 12 x 7 3/8''

This advertising would not lead prospective purchasers to conclude that applicant's design for its crab trap is in fact a trademark for its goods. While applicant has provided some examples of its advertising, applicant has not included the dollar amount or the extent of its advertising. The fact that applicant has submitted examples of advertising does not demonstrate that its mark has acquired distinctiveness. See In re Enco Display

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<sup>8</sup> In a case like this where applicant's alleged trademark reads more like a patent claim ("a three dimensional product design configuration of a crab trap having a generally square foot print and a height generally 40% and 60% of its length or width"), it is not clear how potential purchasers would conclude that a crab trap with applicant's dimensions is a trademark. Certainly, the advertising of record does not give potential purchasers much of a clue that applicant's crab trap design is a trademark.

Systems, Inc., 56 USPQ2d 1279, 1284 (TTAB 2000)

("Advertising amounts ranging from \$51,000 to \$74,000 during 1986-97" did not "support a finding of acquired distinctiveness").

In addition, applicant's evidence that competitors have discontinued use of similar designs is a poor substitute for consumer recognition that its design functions as a trademark. In re The Wella Corp., 565 F.2d 143, 196 USPQ 7, 8 n.2 (CCPA 1977)("Appellant argues that various letters (of record) from competitors indicating their discontinuance of use of its mark upon threat of legal action are evidence of its distinctiveness, but we agree with the TTAB that such evidence shows a desire of competitors to avoid litigation rather than distinctiveness of the mark"); In re Consolidated Cigar Corp., 13 USPQ2d 1481, 1483 (TTAB 1989) ("Evidence that competitors may have agreed to discontinue use of WHIFFS upon threat of legal action by applicant shows a desire by those competitors to avoid litigation, rather than distinctiveness of WHIFFS"). See also In re The Original Red Plate Co., 223 USPQ 836, 839 (TTAB 1984)("[T]he fact that the suit was settled in applicant's favor is not persuasive evidence of distinctiveness because it can just as readily be taken as

evidence of the defendant's desire to avoid the expenses of litigation").<sup>9</sup>

Finally, the evidence of other patents with designs similar to applicant's is significant evidence that applicant's design has not acquired distinctiveness.

Accord In re Pacer Technology, 338 F.3d 1348, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003) ("We agree with the Board that the adhesive container caps in these design patents are 'probative' of the fact that consumers would not find [applicant's] adhesive container cap design to be unique or unusual"). Therefore, we conclude that applicant has failed to meet its burden of demonstrating that its design has acquired distinctiveness and even if its design were not functional, it would not be entitled to registration.

Decision: The refusal to register applicant's design on the Principal Register on the basis that it is de jure functional is affirmed. If the mark is not functional, the

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<sup>9</sup> Indeed, we do not have to speculate in at least one instance that this was exactly the competitor's motivation. "American Maple does not agree that the alleged trade dress is protectible, and does not agree that Danielson has any protectible rights in the design in questions. All rights and claims are hereby reserved. However, our client has stopped all activities relating to the crab cage in question. *American Maple has sold only a total of 7 pieces altogether, and all before receiving notice from you.*" Letter from Danton K. Mak dated November 20, 2002 (italics added).

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refusal to register the mark on the ground that it has not acquired distinctiveness is also affirmed.